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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,411	02/06/2002	Jamie J. McNutt	P99047US2A	4690

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/068,411

Applicant(s)

MCNUTT ET AL.

Examiner

Katarzyna Wyrozebski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of applicants request for continuing examination following non-final office action is necessitated.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over LAUBE (US 5,426,147) in view of evidence in KITAHARA (US 4,525,541).

The prior art of LAUBE discloses rubber composition used in tire inner liners comprising large sized carbon black and rubber among other conventional additives.

The carbon blacks of the prior art of LAUBE are numbered 1*, 2* and 3* and are described in Table I in col. 5. The DBP values of carbon blacks 1* and 3* are 39.1 and 29.1 respectively. The iodine values for carbon black 1* and 3* are 16.5 and 27.6 respectively. These carbon blacks are utilized in examples 7, 8, 11 and 12 as depicted in Table III in col. 5-6. The resulting Mooney viscosities of these compositions are 74.2, 77.2, 65.5 and 68.4 for examples 7, 8, 11 and 12 respectively.

In addition to bromobutyl rubber in Table II (col. 5) the rubbers that are disclosed in col. 2 of the specification of LAUBE include SBR (lines 15-24), polybutadiene, polyisoprene and copolymers thereof.

The amounts of the carbon black in addition to 90 and 100 parts disclosed in Table II is also described as a range of 10-200 parts by weight of rubber in col. 2, lines 25-26 of the specification of LAUBE.

Although the prior art of LAUBE discloses different part of a tire made from the prior art composition, one of ordinary skill in the art would also know that other parts such as bead filler

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could also be made from the same composition as evidenced in the col. 5, lines 3-6 of the cited disclosure of KITAHARA.

The present claims now require for the composition to contain mixture of the two carbon black, which mixture is viewed as obvious modification.

It is well settled that it is prima facie obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Linder* 457 F.2d 506,509, 173 USPQ 356, 359 (CCPA 1972).

In view of the above case law, it would have been obvious for one having ordinary skill in the art at the time of the instant invention to utilize mixture of two carbon blacks in the composition of LAUBE and thereby obtain the claimed invention. Such modification would still provide rubber composition for use in tires.

Applicant's arguments submitted with request for continued prosecution are considered moot since they address anticipation rejection. The rejection of record as stated herein is obviousness type rejection.

Claim Objections

5. Claims 4 and 11 are objected to because of the following informalities: Claims 4 and 11 recite rubber comprising monomers that have "about" X carbon atoms. With respect to the amount of the carbon atoms, applicants either have 4 carbon atoms or they don't. butadiene does

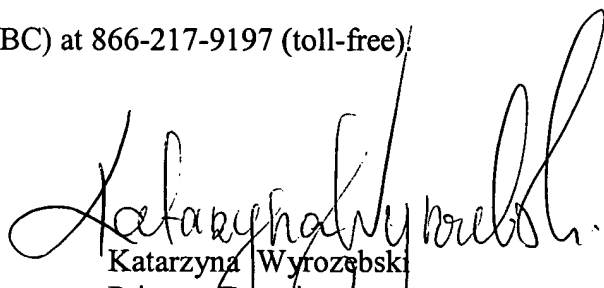
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not have about 4 carbon atoms. It has 4. The same argument would apply to 12 carbon atoms monomer. Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katarzyna Wyrozebski
Primary Examiner
Art Unit 1714

December 17, 2004